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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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AXYS PHARMACEUTICALS, INC.
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In re Application of :
Darin A. Allen et al :
Serial No.: 09/737,687 : PETITION DECISION
Filed: December 14, 2000 :
Attorney Docket No.: 218 :

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This is a decision on the petition under 37 CFR 1.144, filed March 24, 2003, requesting review of an improper restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 on December 14, 2000. The examiner assigned to the application mailed a first Office action to applicants on July 30, 2001, setting a one month shortened statutory period for reply, and setting forth a restriction requirement as follows:

- Group I, claims 1-8 and 10-17, drawn to compounds of Formula I;
- Group II, claims 20-27, drawn to a process;
- Group III, claim 9, 18-19 and 28-31, drawn to a the method of use.

The examiner reasoned that the groups were distinct from each other because they differ in structure and/or element. The examiner also stated that claims 1-31 were generic to a plurality of patentably distinct species and required an election of species within whichever Group was elected. The examiner additionally stated that upon election of a species a generic concept inclusive of the elected species would be identified.

Applicants replied on October 15, 2001, electing Group I and a species with traverse as to the examiner's expected requirement that the claims be limited to subgeneric concept. Applicants' arguments center around the procedures outlined in M.P.E.P. 803.02. Applicants did not traverse the restriction requirement with respect to Groups II and III (see last page of reply). On December 5, 2001, the examiner mailed an Office action to applicants setting a three month shortened statutory period for reply. The examiner replied to the traverse summarizing applicants' statements for traversal and then responding to the traversal as if it was a traversal of

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the restriction requirement between Groups I-III. The examiner then created a subgeneric concept from applicants' elected species as shown on page 3 of the Office action. The examiner objected to claims 1-8 and 10-17 as containing non-elected subject matter. The elected claims were also rejected under 35 U.S.C. 112, second paragraph, as indefinite for various reasons.

Applicants replied on June 24, 2002, including a petition for revival for unintentional abandonment and fee therefor which was granted August 30, 2002. The reply amended claim 1 and canceled claims 9 and 18-31, all of the claims of Groups II and III above. The amendments were argued as overcoming the rejection under 35 U.S.C. 112, second paragraph. Applicants again traversed the restriction requirement for the same and additional reasons, citing several court decisions thereon.

The examiner mailed a Final Office action to applicants on November 20, 2002, again responding to the traversal of the restriction requirement and maintaining it as proper, and requiring applicants to cancel the non-elected subject matter.

Applicants replied on March 24, 2003, with an Amendment after Final rejection, a Notice of Appeal and a petition under 37 CFR 1.144 regarding the restriction requirement. The petition and amendment present essentially the same arguments regarding the impropriety of the restriction requirement. It should be noted that applicants and examiner both use the term restriction requirement when referring to the election of species requirement.

DISCUSSION

Applicants argue that the restriction requirement, specifically the election of species, and the examiner's actions following it are improper. Applicants state that according to M.P.E.P. 803.02 following an election of species requirement in which a species has been identified the examiner must examine the chosen species. If the elected species is found allowable over the prior art then the examiner must expand the search and examination to a reasonable number of additionally claimed species (i.e. - to a subgenera). Again, if no prior art is found after examining the additional species, the application is to be allowed. Applicants cite both *In re Haas* and *In re Weber* as support for their position. Applicants conclude by stating that the examiner's requirement to cancel non-elected subject matter from the claims amounts to a rejection of the claim (or part of the claim) and a denial of substantive rights.

The examiner argues in substance that 35 U.S.C. 121 gives the Commissioner authority to restrict an application to one invention where two or more inventions are claimed. The examiner states: "the requirement in this application is predicated on the fact that the elected subject matter taken as a whole and the non-elected subject matter taken as a whole are so different in structure and element as to be patentably distinct...", and that "Applicants have not argued otherwise or presented any evidence to show that the various groups constitute the same invention..." The examiner further states that to consider all the subject matter presented would be burdensome to the examiner as numerous classes and subclasses would be involved as would numerous searches in the literature.

It is clear from the prosecution of the application that the examiner has failed to follow the procedures outlined in M.P.E.P. 803.02 following an election of species. The examiner appears to consider the election of species as a restriction requirement rather than an election of species requirement. The examiner by argument alleges that the subject matter of the claims encompasses numerous classes and subclasses, but presents no evidence thereof. The examiner has not shown or alleged that the compounds encompassed by Formula I are so different that they would be separately classified and support separate patents. Absent such a showing the examiner has failed to sustain a burden on the Office. Until such a showing is made by the examiner applicants are under no obligation or requirement to present evidence to the contrary, as supposedly required by the examiner. A review of the file wrapper shows that the examiner has searched one subclass in each of two classes and performed a CAS Online search for the elected species (or subgeneric concept) identified. Such a limited search, even if expanded, could not be considered burdensome to the examiner. The examiner's arguments have also not shown how the elected subject matter differs significantly in structure from the non-elected subject matter. Had the examiner done so a proper restriction between compounds having significantly different common structures may have been appropriate. The examiner did not do this, but elected to proceed under the umbrella of an election of species requirement thus implying that the base claim (claim 1) was generic to all other claims and that all species thereunder were properly related. (It is noted that claims 20-27 do not depend on claim 1 and encompass no species, thus no species could have been elected as required in the original restriction requirement.) By virtue of the election of species requirement the examiner has, *sub silento*, indicated that M.P.E.P. 803.02 would be followed. It is noted that M.P.E.P. 803.02 does not require all claimed species to be examined, only a reasonable number to determine whether the entire genus is allowable.

DECISION

Applicants' petition under 37 CFR 1.144 is **GRANTED**. Claim 1 will be examined in its full breadth in accordance with M.P.E.P. 803.02. In view of this **the last Office action (and its finality) is withdrawn as improper**.

The application will be forwarded to the examiner for further action not inconsistent with this decision.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.



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